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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188973
Party	Defendant Nasser, Gulam
Correspondence Address	DIANE DONNELLY VON MALTITZ, DERENBERG, KUNIN, JANSSEN & 60 EAST 42ND STREET NEW YORK, NY 10165 ddonnelly@vonmaltitz.com
Submission	Answer
Filer's Name	Gulam Nasser
Filer's e-mail	johnny@beautywholesale.co.uk
Signature	/Gulam Nasser/
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Answer to the Opposition

The Applicant Gulam Nasser takes the following position on the various assertions of the Opponents:

1. Applicant Gulam Nasser ignores if the data given on the identity and activities of the Opponents corresponds to the reality.

2. Applicant Gulam Nasser is a citizen of the United Kingdom.

3. Applicant contests that the Opponents would be damaged by Applicant's registration of the trademark SWISS SOFT 'N WHITE. His arguments will be developed on point 6 hereunder.

4. On the basis of the USPTO registers, it can be confirmed that Gapardis is the owner of the US trademarks No. 2839374, No. 2497918 and No. 2934710. But the following has to be specified:

    a. U.S. Registrations No. 2839374 and No. 2497918 are exclusively registered in class 003, for beauty and skin care products, namely soaps, lotions, milks, creams and gel for the face and body.

    b. The scope of protection of U.S. Registration No. 2934710 is wider, as this application covers a wider range of products, but, as the other applications, only in class 003.

    c. The Trademark FAIR & WHITE PARIS has been also filed, in particular, in France on September 29, 1999, before the World intellectual property organization on February 28, 2000 (exhibit 1), and before the UK Intellectual Property Office through the International registration (exhibit 2).

5. The assignment of the trademarks from Xavier Tancogne to Gapardis results from the Register. The Opponents don't tell if their trademarks are actually used in the U.S. or not.

6. Opponents argue that the application SWISS SOFT 'N WHITE of the Applicant is used with goods that are identical or closely related to goods marketed and distributed by Gapardis, and that this Trademark is likely to cause confusion, or to cause mistake, or to deceive. These arguments are entirely contested, for the following reasons:

    a. First of all, it has to be clarified that the nature and scope of a party's goods must be determined on the basis of the goods recited in the application and/or registration (Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002), and not on the basis of the products effectively marketed and distributed by the Opponents.

    b. To determine the likelihood of confusion, one has to examine the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. In the prospective, the comparison between the trademarks in their entireties doesn't reveal any likelihood of confusion. The appearance, the sounds, the connation as well as the commercial impression is clearly different. The sole similarity is the word "white", which is clearly generic and a weak element of the trademarks to be compared. Therefore the likelihood of confusion has to be denied.

c. According to the Trademark Manual of Examining Procedure (section 1207.01(b)(viii), "when assessing the likelihood of confusion between compound word marks, one must determine whether there is a portion of the word mark that is dominant in terms of creating a commercial impression. Although there is no *mechanical test to select a "dominant" element of a compound word mark, consumers* would be more likely to perceive a fanciful or arbitrary term rather than a descriptive or generic term as the source-indicating feature of the mark. Accordingly, if two marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely (citations omitted). If the common element of two marks is *"weak" in that it is generic, descriptive or highly suggestive of* the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality (citations omitted)". As the applicant's one, the Trademarks of the opponents contains compound word marks. The only word that is common to both trademarks is the word "white". If one has to consider that this word is the "dominant" element of each Trademark, it should be considered that the Applicant's one doesn't create any likelihood of confusion, as the word "white" is clearly a generic and descriptive word. If one has to consider that the word "soft" or the word "Swiss" in the Applicant's Trademark is dominant, the result is the same, as one has to consider that there isn't any likelihood of confusion, as the dominant words are neither identical nor similar to the dominant words of the Opponent's trademarks.

d. Another reason to deny the likelihood of confusion is the origin which appears in the wording of the trademarks and which is clearly different ("Paris" for the Opponents, "Swiss" for the Applicant). Everybody, and in particular any client, is able to make the difference and to determine, for instance, that Paris is not the main town of Switzerland.

e. The opponents argue also that the Applicant's trademark is deceptive. This is clearly not the case. This mark has been duly registered and respects all the legal requirements for such a registration. Obviously the Applicant's trademark cannot be invalidated for deceptiveness.

f. The Applicant has registered the trademark SWISS SOFT 'N WHITE in the UK, and in the European Community since April 23, 2008 (registration certificates in attachment), without any opposition from the Opponents. It is difficult to understand the reasons why the Opponents have not made any opposition in the UK and the European Community, but only in the U.S.

7. The Applicant ignores when the Opponents began to use their trademarks in the U.S. But the priority claimed by the Opponents is not relevant, as the Applicant's trademark does not create any likelihood of confusion with the Opponent's ones.

8. As already mentioned, the likelihood of confusion between the trademarks is contested, and clearly non-existent. Consequently, Applicant's declaration of his right to use the Trademark SWISS SOFT 'N WHITE in commerce was obviously not false and fraudulent.